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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,297

06/30/2005

Jurgen Kress

6636

60333 7590 07/10/2007  
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EXAMINER
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NIA, ALIREZA

ART UNIT	PAPER NUMBER
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3709

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/541,297

Applicant(s)

KRESS, JURGEN

Examiner

Alireza Nia

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **OBJECTIONS**

### ***Specification***

The disclosure is objected to because of the following informalities: typographical errors (page 5, lines 2, 16, and 18).

Appropriate correction is required.

## **REJECTIONS**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29, 30, 32-35, 38, 41-43, and 46-48 rejected under 35 U.S.C. 102(b) as being anticipated by Silverstein US 4,646,722, that teaches the invention as claimed.

Silverstein discloses an endoscope 12 with hygiene protection comprising a flexible and elastic cover 48 (col. 6, lines 62-65) closed at a distal end 30 and transmissible for optical information through a transparent lens 32 forming front face of distal end 30 (col. 6, lines 1-3 and figure 2), and capable of being rolled in an axial direction of endoscope 12 (col. 6, lines 63-66). It is also disclosed that the internal diameter of cover 48 is larger than the external diameter of endoscope 12 (col. 7, lines 56-59). Silverstein also teaches an optically transparent cap 112. Silverstein further discloses one working channel 38 extending parallel to endoscope 12 and terminating in an open mode 40 at distal end 30 of cover 48. Moreover, one vacuum channel 36 is

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taught having an opening 54 which is the means for applying pressure to channel 36 which terminates inside of cover 48 (col. 6, lines 39-44 and col. 7, lines 26-28) and extending for a portion of the length of cover 48 (col. 7, lines 1-4). Further, at least one working channel 39 is connected only to distal end 30 and positioned between depressions 21 on an outer surface of endoscope 12 where depressions 21 accommodate working channel 39 and vacuum channel 36 (col. 6, lines 16-24 and col. 6, lines 16-24). Furthermore, working channel 39 and vacuum channel 36 are fixed to distal end 30 (col. 6, lines 39-42). Silverstein's disclosure teaches a cover 48 that is fixable to be airtight on a shaft of endoscope 12 (col. 7, lines 39-65). The elastomeric material of cover 48 inherently is the means for varying the cross-sectional diameter of cover 48 (col. 7, lines 56-58), therefore inherently allowing the inner diameter of cover 48 to be larger than the outer diameter of the endoscope. Moreover, Silverstein teaches the use of a coating to coat an inner side of window 32 and optical channel of endoscope 12 (col. 6, lines 5-57). Silverstein's disclosure teaches the invention as discussed above in addition to anticipating the methods of attaching a hygiene protection system to an endoscope.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722 in view of Sidall US 4,741,326.

Silverstein teaches the invention as discussed above with the exception of the following claimed limitation taught by Sidall: A flexible elastic sheath 1 that prevents the contamination of an endoscope (col. 3, lines 6 and 10-11). It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the flexible and elastic properties of the cover 48 taught by Silverstein in view of the sheath 1 taught by Sidall in order to serve as a protective barrier to prevent bacterial and virus particles from coming into contact with the endoscope device.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722 in view of Nakao US 5,217,001. Silverstein teaches the invention as discussed above including an end cap 112 being of rigid material mounted to a cover of elastomeric material 114 (col. 9, lines 40-44) with the exception of the following claimed limitation taught by Nakao: Nakao discloses a transparent end cap 24 (col. 5, line 43). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the distal end 30 as disclosed by Silverstein in view of the transparent end cap 24 of Nakao to have made an optically transparent cap on the distal end 30 in order to illuminate body tissue by emitting illuminating light from the endoscope. It would have also been obvious to one of ordinary skill in the art at the time of invention to have conceived the wall thickness of a rigid material to be greater than the wall thickness of a flexible elastomeric material in order to be able to form the elastomeric material into a roll.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722. Silverstein teaches multiple U-shaped cutouts or grooves 21 to accommodate multiple channels (col. 6, lines 16-24) on the endoscope. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the U-shaped grooves 21 such that a width in the axial direction of the endoscope 12 is smaller than the width of the depression 21 at their center points in order to securely receive the channels 38, 39, and 36 onto the endoscope 12 when the cover 48 is unrolled over the endoscope.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722 in view of Viebach US 6,077,219. Silverstein teaches the invention as discussed above entailing a cover 48 made of elastomeric material wherein the material is fixable via a chemically inert and non-toxic adhesive, with the exception of the following claimed limitation taught by Viebach: Viebach teaches a cone-shaped cover which slips over an endoscope (col. 2, lines 42-51). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified cover 48 in view of the cone-shaped cover of Viebach to make a cover 48 that conically enlarges wherein it is fixable via an adhesive in order to give the practitioner the option of extending the cover 48 over larger surgical instruments and securely sealing the cover over and onto the instrument prior to the start of the operation.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722 in view of Domeier US 7,101,358. Silverstein teaches the

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invention as discussed above with the exception of the following claimed limitation taught by Domeier: Domeier teaches a tear tape 3 extending around a wrapper. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified cover 48 in view of Domeier's tear tape 3 to connect a tear thread in order to function as an efficient and sanitary taking-off means of the cover by the practitioner after use.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverstein US 4,646,722 in view of Adair US 5,630,782. Silverstein teaches the invention as discussed above with the exception of the following claimed limitations taught by Adair: working channels S being detachably connected to an end cap (col. 5, lines 23-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified distal end 30 and at least one working/vacuum channels as taught by Silverstein in view of the detachable working channels S as taught by Adair to have made at least one working channel 39 and vacuum channel 36 detachably connected to distal end 30 in order to simplify the repair, maintenance, and cleaning of the channels with respect to the distal end.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alireza Nia whose telephone number is 571-270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenburg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Aliya  
07-5-07

Kim Smith  
Kim Smith  
Patent Examiner  
7/5/07